REMARKS

Claims 1-4 and 13 are pending in the instant application. The Examiner has withdrawn Claims 14-28 and has rejected Claims 1-4 and 13. Applicants have amended Claims 1, 2 and 4.

Applicants expressly reserve the right to file continuation applications directed to the subject matter not currently being pursued.

Section 102(b)

The Examiner has rejected Claims 1-4 and 13 under 35 USC 102(b) as allegedly being anticipated by US Patent No. 4,332,810 ('810) or Belanger et al., *Preparation and Stereochemistry of 8- and 9-Hydroxy-2,5-ethano-3-benzacines*, CAN. J. CHEM, 61: 2177-2182 (1983).

Applicants respectfully traverse this rejection. For a single reference to anticipate an invention, the reference must, either expressly or inherently, disclose each and every element of the claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 221 U.S.P.Q. 385, 388 (Fed. Cir. 1984). Applicants have amended Claims 1 and 2 so that R^1 is not OR^4. The compounds and generic formula disclosed in the '810 patent and the Belanger et al. article require a hydroxy or methoxy substitution in the R^1 position of the Formula I of the instant invention. Applicants assert that the claims of the instant invention are not anticipated by the Belanger references as Formula I does not allow for a hydroxy or methoxy substitution at the R^1 position. Because each and every element is not disclosed in the cited references, Applicants assert that the references do not anticipate the claimed invention. Therefore, Applicants respectfully request that this rejection be withdrawn.

The Examiner has also rejected Claims 1-3 and 13 under 35 USC 102(b) as allegedly being anticipated by Iddon et al., *Synthesis and Reactions of 2,3,4,5,6-tetrahydro-2,5-ethano-3-benzazocin-4(1H)-one and a thieno-extened analogue: X-ray structure of 3-methyl-2,3,5,6-tetrahydro-2,5-ethanol[1]benzothieno[3,2]azocin-4(1H)-one*, J. CHEM. SOC. PERKIN. TRANS, 1(4): 1083-1090 (1990).

Applicants respectfully traverse this rejection. Applicants note that a proviso has been added to Claim 1 so that $\frac{S}{S}(CR^{1a}{}_2)_n - X - (CR^{1a}{}_2)_p - V - (R^2)_q$ is not equivalent to H or CH_3.

Unlike Formula I of the instant invention, the nitrogen atom of the compounds disclosed in Iddon et al. have either an H or CH_3 attached. The Iddon compounds do not allow or suggest any further substitution. Because each and every element is not disclosed in the cited references, Applicants assert that the references do not anticipate the claimed invention. Therefore, Applicants respectfully request that this rejection be withdrawn.

Section 103

The Examiner has rejected Claims 1-4 and 13 under 35 USC 103(a) as allegedly being unpatentable over US Patent No. 4,332,810 ('810).

Applicants respectfully traverse this rejection. According to section 2141 of the M.P.E.P., the "following tenets of patent law must be adhered to [when determining if an invention is obvious]:

A) The claimed invention must be considered as a whole;

B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention, and

D) Reasonable expectation of success is the standard with which obviousness is determined." (citations omitted)

Applicants respectfully contend that the invention, *as a whole*, is non-obviousness because the references cited by the Examiner do not teach or suggest the instant invention. Applicants also respectfully contend that there is no motivation or suggestion that the references cited by the Examiner be combined. Additionally, Applicants respectfully assert that the Examiner is using an "obvious-to-try" theory to allege that the instant invention is obvious and would have had a reasonable expectation of success.

As noted above, the compounds of the instant invention do not allow for R^1 to be OR^4. The compounds and generic formula disclosed in the '810 patent require a hydroxy or methoxy substitution in the R^1 position of the Formula I of the instant invention. Applicants respectfully assert that there is no suggestion or teaching in the '810 patent that would motivate one with ordinary skill in the art to modify the compounds disclosed therein to arrive at the claimed invention.

The Examiner has suggested that one with ordinary skill would be motivated to modify the compounds of the '810 patent with bioisosteric replacements and cites the Patani et al. reference as showing that a bromine and a hydroxyl-group function as bioisosteres.

Applicants note that the Patani et al. reference shows several isosteres and bioisosteres and indicates that, although the atoms or groups may fall into such categories, individual atoms or groups may demonstrate "a weaker pharmacological response" (p. 3153). Additionally, on page 3154, the authors note that the thiol bioisostere was more potent than the other bioisosteres and on page 3155, the authors state:

> "it could be inferred that the enzyme has steric and electronic preferences at this position, resulting in significantly enhanced potency for the hydroxyl and chloro substituted compounds"

Applicants wish to point out that on page 3155 of the Patani et al. reference, Table 16 shows that the bromine group was significantly less potent than the other bioisosteres.

Applicants respectfully assert that the references cited by the Examiner do not render the instant invention obvious. Rather, Applicants believe that the Examiner's rejection amounts to hindsight reconstruction which has been repeatedly struck down by the court as being improper. In Eli Lilly, the Federal Circuit defined an "obvious to try" situation as one where "a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued." 14 U.S.P.Q. 2d 1741, 1743 (Fed. Cir. 1990). While the references could have stimulated an inventor's interest, the references themselves do not sufficiently teach or suggest the instantly claimed compounds. As a result, the rejection improperly denies the application on an "obvious to try" theory.

For the reasons above, Applicants contend that the reference does not render the instant invention obvious and respectfully request that this rejection be withdrawn.

Applicants respectfully contend that Claims 1-4 and 13, as amended, are allowable and an early Notice of Allowance is earnestly solicited. If a telephonic communication will aid in the advancement of the prosecution of this application, please telephone the representative indicated below.

Respectfully submitted,

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